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10/747,728	12/29/2003	Marvin J. Williams JR.		2033

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EXAMINER

VALENTI, ANDREA M

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/747,728
Filing Date: December 29, 2003
Appellant(s): WILLIAMS, MARVIN J.

MAILED

DEC 06 2007

GROUP 3600

Adrienne B. Naumann, Esq.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 18 September 2007 appealing from the
Office action mailed 10 February 2006

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief:

Marvin J. Williams, Jr.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 1-7 and 9-13.

Claims 8 and 14-20 are withdrawn from consideration as not directed to the elected species.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

The amendment after final rejection filed on 27 March 2006 and 23 June 2006 have not been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

A substantially correct copy of appealed claims 1-7 and 9-13 appears on page A1-A7 of the Appendix to the appellant's brief.

The minor errors are as follows:

Claim 14 is a withdrawn claim and is not included in the set of claim under appeal. However, applicant included claim 14 in the appendix of claims. This claim was amended in a 28 November 2005 amendment but does not reflect the amendments in the claim appendix. This may not be an issue since the claim is withdrawn and not currently under appeal.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112 The following is a quotation of the first paragraph of 35 U.S.C. 112: The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. In the independent claims, the harvesting of the first portion of the annual green crop and its mixing to become a combined green manure is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The independent claims recite "spraying said first portion of said combination mulch" but there is no step between mowing the annual green manure and harvesting and combining the its first portion to arrive at the combination mulch so it can be sprayed.

(10) Response to Argument

Examiner maintains Claims 1-7 and 9-13 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The method steps of forming the first and second portions of the combined green manure critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Also, that the claim as written cover a method not enabled by the specification.

Applicant's specification page 21 paragraph (78) states: "*Referring to Figure 3, wheat grass 18a (consisting of the upper portions of young wheat 17 and/or buckwheat 18 plants) remains viable until it is mowed immediately prior to spring tilling. The top approximate one-half of wheat grass 18a is chopped and blended with organic debris 19 to become combined mulch 20, as explained in more detail infra. The remaining approximately one-half of the bottom portions of green manure plants 44 (such as*

wheat grass 18a), is tilled into soil 45 with organic debris 19 prior to spring seeding of intercropped commercial plants."

Paragraph (78) of applicant's specification indicates that the first portion of combined green manure is created by cutting the top half of the annual green manure crop and mixing it with organic debris. Then the second portion is created by tilling the bottom half of the annual green manure crop with soil and organic debris. This is very different then what is claimed in independent Claims 1 and 9. **The method steps outline in paragraph (78) are essential elements that are omitted from the claims.**

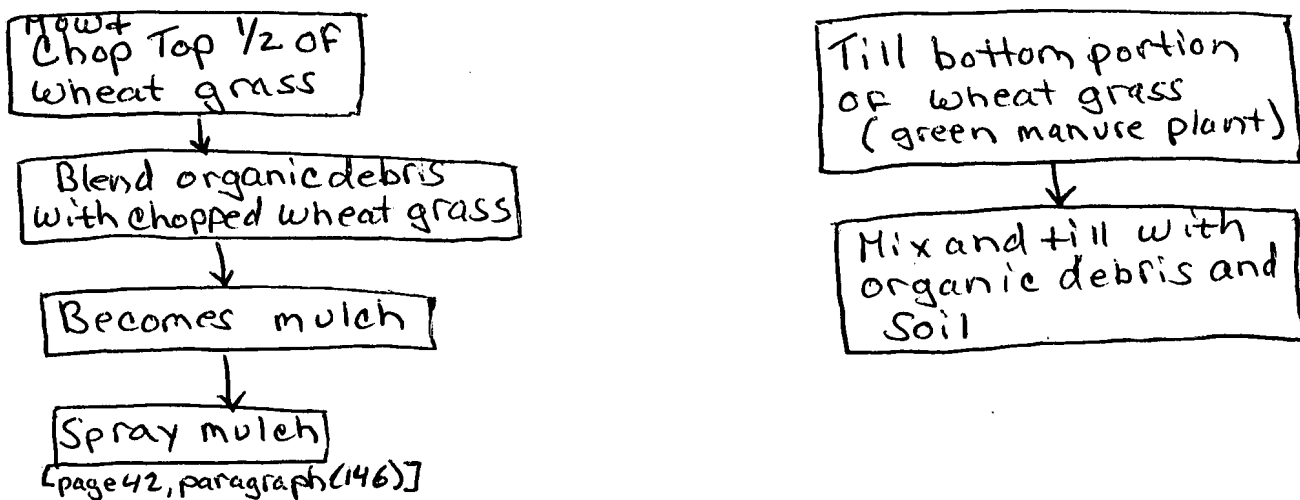
In independent claim 1, applicant claims the following: "(2) mowing said annual green manure crop the following spring, said annual green manure crop being combined with organic residue from said predetermined area to form combined green manure, said organic residue comprising desiccated intact soybean roots and desiccated intact nitrogen nodules, said combined green manure comprising a first portion of said combined green manure and a second portion of said combined green manure, said second portion of said combined green manure further blended with said soil of said predetermined area to a depth of approximately nine to fourteen inches, said first portion of said combined green manure becoming a combination mulch, said annual green manure crop remaining unmowed until tillage of said soil,"

Thus, applicant's claim 1 and 9 present a very broad method that could be interpreted to mean that the annual green manure crop is mowed down completely in one step and all of it is combined with organic debris to create a combined green manure. Once combined the combined green manure is broken into a first portion and

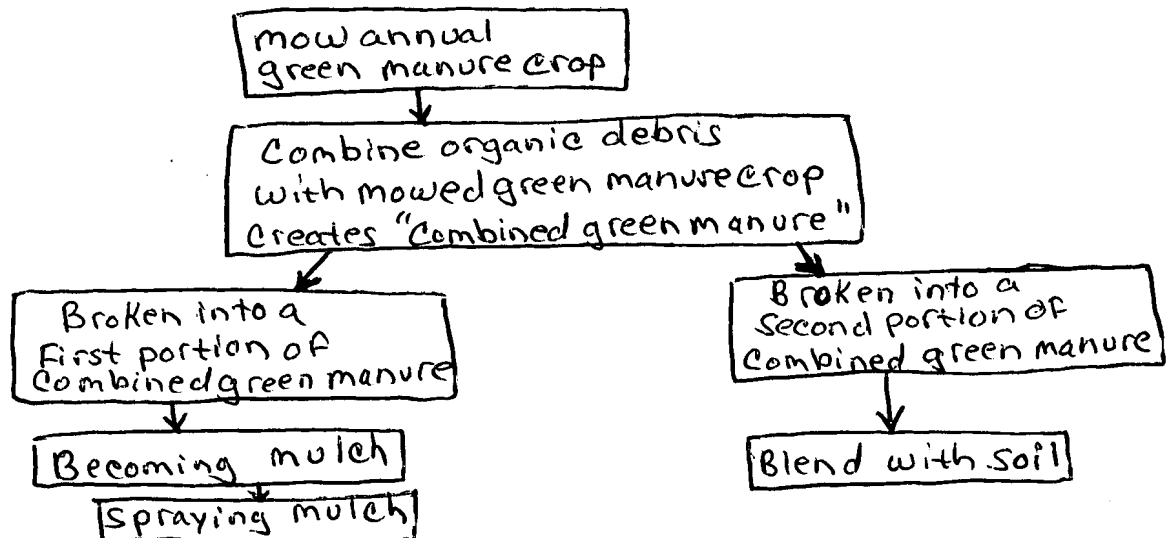
a second portion. This is not disclosed in the specification. Therefore, applicant's claims cover a method not enabled by the specification.

Please see the diagrams below for a comparison of the what is disclosed in the specification and what is claimed in the claim limitations.

Paragraph (78) page 21 Applicant's Specification:



Applicant's independent Claim 1 and 9 method steps:



Therefore, the examiner maintains that essential elements are omitted from the claims and that the claims as written cover a method not enabled by the specification.

Applicant presents arguments regarding the after final amendments that were not entered, requesting that the denied entry be reversed and that the claim amendments be entered; however, this is not an appealable issue and is a matter addressed through a petition.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Andrea M. Valenti
Primary Examiner
Art Unit 3643

29 November 2007

Conferees:

Andrea M. Valenti 

Meredith Petravick 

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